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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,001	01/16/2004	Eugenio Cruz Garcia	5724.012.21-US	5034

30827 7590 09/19/2006

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EXAMINER

LAUX, JESSICA L

ART UNIT PAPER NUMBER

3635

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/758,001	Applicant(s) GARCIA, EUGENIO CRUZ	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Acknowledgement is made of applicants reply filed July 28, 2006. The specification and drawings have been amended accordingly. Claims 1-3 remain cancelled and claims 4-12 remain as previously presented.

In light of applicants remarks an examination of claims 4-12 is presented below.

#### ***Response to Arguments***

Applicant argues, in the remarks filed on July 28, 2006, the 35 U.S.C. 112 rejection of claim 10 stating that paragraphs [0017] and [0032] of the specification provide support for the forms of machining of the flooring product.

Examiner maintains the rejection, and responds to applicant's arguments by pointing out that paragraphs [0017] and [0032] do not clarify the claim or enable one of ordinary skill in the art to make the claimed article. Paragraph [0017] is directed the surface texture and paragraph [0032] is directed machining tongue and groove connections. Neither paragraph [0017] or [0032] either alone or in combination provide support for a visual pattern extending onto the edge contour or the associated machining resulting in the claimed features.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, it is not understood how the visual pattern on the surface of the product may extend into the edge contour. Specifically, claim 10 depends from claim 4 which states that the product is mechanically pressed and cut, and includes an edge contour machined on the perimeter of the product. Machining of an edge contour would remove the patterned layer at the top edge surface of the product. Furthermore, this feature is not disclosed in the specification to enable one of ordinary skill to make it. Clarification or deletion of this claim is required.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4, 5-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (6146252) in view of Piacente et al (5858160).

Regarding claims 4, 5-9, 11, 12: Martensson discloses a laminated material comprising cellulose sheets impregnated with resin that are mechanically pressed and cut into a product (Col. 3, lines 21-44 and claims 15-19). The product includes a surface with a machined edged contour (14 and 18, Figure 2 and Col. 1, lines 21-28) and an interior region (top surface of 13, Figure 2), where in the edge contour lies below the interior region. While the edge contour is shown to have a substantially linear cross-sectional shape from the interior region to an edge of the product (14, Figure 2), Martensson discloses that the edge contour may also have smooth edges, as in forming curved grooves and tenons for floor boards that are joined side by side (Col. 1, lines 21-

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28). The laminate also comprises one patterned sheet (Col. 3, lines 26-28). Since the patterned sheet is laminated as a layer of the product prior to edge contouring, the pattern will not extend into the edge contour.

Martensson does not disclose the laminated material to have a surface texture that varies in accordance with a visual pattern that imitates another product. Piacente et al. discloses a panel for flooring that has a surface texture that varies in accordance with a visual pattern that imitates another product (Col. 3, lines 26-28; Col. 1, lines 53-57).

In view of Piacente et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the top surface of Martensson's floor panel with impression that follow the underlying décor to enhance the realistic effect of the décor.

It is noted that applicant's claims pertaining to the method of manufacture do not further limit structural features of a product claim and therefore are not considered. Specifically, method of manufacturing steps include: "cellulose sheets...that are mechanical pressed and cut into a product" (claim 4, lines 1-2), "the surface is mechanically formed" (claim 4, line 5), "wherein the edge contour is machined" (claim 4, lines 7), "the machining of the edge contour comprises mechanical scraping" (claim 7), "the machining of the edge contour comprises milling (claim 8), and "the machining of the edge contour comprises cutting" (claim 9).

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

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09/14/2006

  
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